

### **REMARKS**

The above amendments and below remarks are presented in response to the Office Action of June 4, 2003. No new matter has been entered. Entry of the amendments and reconsideration of the referenced application is respectfully requested.

#### **Claim Rejections – 35 USC 103**

Claims 1, 5, 16, 17, 19, 20, and 23 stand rejected under 35 USC 103(a) as being unpatentable over Murphy (U.S. Pat. No. 4,958,252) in view of Dougherty (U.S. Pat. No. 6,356,426).

The Examiner admits that Murphy does not disclose a non-volatile memory (55) storing frame current and rating current, and turns to Dougherty as disclosing *“a control circuit breaker (30) having a non-volatile memory (col. 4, lines 24-27) storing frame current (note the control circuit 30 can maintain a certain current level when the value of rating current resistor is changed (40)) and rating current in digital format only (col. 5, lines 23-51).”*

Applicants respectfully contest this rejection for at least the following reasons:

First, the Examiner’s attention is kindly directed to 35 U.S.C. 103(c) which states:

*(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.*

The Examiner’s attention is further directed to MPEP 706.02(I)(2), which states:

*“Application X and Patent A were, at the time the invention of Application X was made, owned by Company Z.”*

*This statement alone is sufficient evidence to disqualify Patent A from being used in a rejection under 35 U.S.C. 103(a) against the claims of Application X.*

Thus, in a clear and conspicuous manner, the undersigned respectfully submits the following:

#### **EVIDENCE TO ESTABLISH COMMON OWNERSHIP**

***U.S. Patent Application No. 09/660,876 and U.S. Patent No. 6,356,426 were, at the time the invention of U.S. Patent Application No. 09/660,876 was made, owned by General Electric Company.***

Thus, in view of the unavailability of the Dougherty reference for this rejection, it is respectfully submitted that this rejection is rendered moot.

Although the Dougherty reference is not available for this rejection, it is further respectfully submitted that the rejection is not proper for lacking motivation.

As specifically recited in Murphy in Col. 5, lines 4-19, the EEPROM 55, as clearly shown in FIG. 3, stores the style or model of circuit breaker (register 57), the serial number of the breaker (register 59), the trip history which is the number of trips weighted by a function of the current interrupted by each trip (register 61), and the number of operations of the operating mechanism (register 63). The memory 55 does not store current rating of the circuit breaker as recited. Nowhere within Murphy is it disclosed, suggested, or made obvious to store the current rating or frame rating of the circuit breaker within the memory 55.

Furthermore, it is respectfully submitted that it would not have been obvious to alter Murphy to store the current rating or frame rating within the memory 55 in the rating plug without the use of improper hindsight. The memory 55 was placed in the rating plug 7 of Murphy for the sole purpose of placing the rating plug 7 into a programmer 83 for reading the *number of operations* of the operating mechanism and the *number of trips weighted by a function of the current interrupted by each trip*. This is to serve the "needs" expressed in Col. 2, lines 4-18 which includes providing a quantitative measure of service life remaining. Murphy does not disclose, suggest, or make obvious any need for altering the rating of the rating plug. Instead, Murphy is only concerned with using the rating plug for displaying the number of operations and operating history of the circuit breaker, and therefore there is no need or motivation suggested for storing the rating in the memory 55.

Thus, it is respectfully submitted that Murphy does not make obvious the features of Claim 1, and furthermore it would not have been obvious to look to Dougherty for ways to revise Murphy et al.

Additionally, it is noted that the Examiner admits that Murphy does not disclose, as recited in Claim 5, a display for displaying the current rating. The display 89 in Murphy is found

on a programmer 83 as shown in FIG. 5, and not anywhere on the circuit breaker 1 as shown in FIGS. 1 and 2. Claim 5 recites that the display for displaying the current rating is included in the circuit breaker, while display 89 does not display current rating. Instead, display 89 is disclosed as displaying the data in the respective registers of the EEPROM. As discussed above with respect to Claim 1, these registers include style or model of circuit breaker (register 57), the serial number of the breaker (register 59), the trip history which is the number of trips weighted by a function of the current interrupted by each trip (register 61), and the number of operations of the operating mechanism (register 63). Since Murphy does not disclose display 89 anywhere on the circuit breaker and does not disclose display 89 displaying current rating of the circuit breaker, it would not have been obvious to one of ordinary skill in the art to provide a display on the circuit breaker of Murphy in order to display current rating.

The Examiner looks to Dougherty as showing *"a display (50) for displaying the current rating (col. 6, lines 5-6)."* The Examiner goes on to conclude that *"It would have been obvious to one having skill in the art at the time the invention was made to modify the circuit breaker of Murphy with a display as taught by Dougherty in order to permit users easily set and reset the current rating depending on the desired use."* Again, as discussed above with respect to Claim 1, there is no motivation to provide an adjustable current rating within Murphy, and therefore it is further without motivation to provide a display in order to display the current rating. Regardless, it is again noted that Dougherty is unavailable for use.

As for Claim 16, which remains unamended, and as for Claim 23, and as discussed above with respect to claim 1, the EEPROM 55 of Murphy et al stores style or model of circuit breaker (register 57), the serial number of the breaker (register 59), the trip history which is the number of trips weighted by a function of the current interrupted by each trip (register 61), and the number of operations of the operating mechanism (register 63). The EEPROM 55 is not disclosed as storing the current rating. Therefore, Murphy et al does not disclose that the current rating is sent to the etu in digital format only. The use of resistors in the rating plug of Murphy et al would indicate that the rating is sent using analog signals, and therefore Murphy et al does not make obvious Claims 16 and 23 as Murphy et al does not send current rating in digital format only, nor is it determined only by the non-volatile memory. While the Examiner looks to Dougherty to supply the missing elements of Murphy et al, it is noted that the motivation to revise Murphy et al as shown by Dougherty is unfounded as Murphy et al has a specific program

for testing the rating plug 7 within a programmer 83 which is not necessarily compatible with a rewrite of the internal mechanisms of the rating plug 7 as suggested by the Examiner.

Regardless, it is again noted that Dougherty is unavailable for use.

For at least these reasons, it is respectfully submitted that Claims 16 and 23 and the claims which depend upon claims 16 and 23 define over Murphy et al.

It is also respectfully noted that since Claims 16-21 remain unamended, a second office action may not be made final should the Examiner apply a new grounds of rejection to Claims 16-21.

Claims 17, 18, 25, 26 stand rejected under 35 USC 103(a) as being unpatentable over Murphy (U.S. Pat. No. 4,958,252) in view of Dougherty (U.S. Pat. No. 6,356,426), and further in view of Bilac et al. (U.S. Pat. No. 6,560,084).

The Examiner turns to Bilac et al to show a label 58 having a bar code. It is again noted, however, that Dougherty is unavailable for this rejection and Bilac does not cure the deficiencies of Murphy on its own. Therefore, it is respectfully submitted that claims 17, 18, 25, and 26 are patentable over the available prior art references.

Claims 21 and 24 stand rejected under 35 USC 103(a) as being unpatentable over Murphy in view of Dougherty, and further in view of Morris et al. (U.S. Pat. No. 4,728,914).

The Examiner turns to Morris et al. to disclose "*a rating plug (17) having a plastic house (20 and 21).*" It is again noted, however, that Dougherty is unavailable for this rejection and Morris does not cure the deficiencies of Murphy on its own. Therefore, it is respectfully submitted that claims 21 and 24 are patentable over the available prior art references.

### **Newly Added Claims**

Claims 40 and 41 have been newly added. No new matter has been added.

Claim 41 recites, "*A circuit breaker for an electrical circuit comprising:*

*an operating mechanism for interrupting current in the electrical circuit when operated;*

*an electronic trip unit including a microcomputer which monitors the current in the electrical circuit and generates a trip by operating the operating mechanism to interrupt the current in the electrical current when the current exceeds a selectable value, the electronic trip*

*unit further establishing the selectable value of the current at which the electronic trip unit trips the operating mechanism; and,*

*a non-volatile memory for storing current rating of the circuit breaker.”*

Claim 40 includes only language utilized in claim 1, and therefore does not include new matter. It is also noted that the memory 55 of Murphy et al does not store current rating, and Dougherty is unavailable as a teaching reference. Therefore, it is respectfully submitted that Claim 40 patentably defines over the available prior art references.

Claim 41 recites, *“The circuit breaker of claim 40 further comprising an error detection program within the microcomputer, wherein the error detection program rejects current ratings sent to the electronic trip unit that are greater than a frame rating of the circuit breaker.”*

Claim 41 essentially repeats the subject matter of Claim 4, and therefore does not include new matter. It is further noted that Murphy does not disclose any sort of error detection program as recited in Claims 4 and 41. The Examiner's prior reference (in the Office Action dated January 2, 2003) to Col. 5, lines 43-50 has nothing to do with a comparison between current ratings and the frame rating. Instead, this section describes how the trip current value (not the frame rating) is compared to the maximum continuous current (which is the current rating). Additionally, if the trip current value detected by Murphy is found to be greater than the current rating, then a count is made and the magnitude of the trip current is calculated. This does not, in any way, imply that the current rating is rejected, as previously suggested by the Examiner, and therefore Murphy discloses no sort of program to reject current ratings that are greater than the frame rating as recited in Claims 4 and 41.

#### **Allowable Subject Matter**

It is noted with appreciation that claims 22 and 37-39 have been allowed.

Claim 37 has been slightly amended to remove the phrase “frame rating and” as this phrase is not critical to the patentability of Claim 37, as assessed by the Examiner, where Claim 37 has been deemed patentable for reciting, in part, a circuit breaker comprising an Internet connection extending from the microcomputer and the rating current of the circuit breaker may be changed via the Internet connection. Thus, it is respectfully submitted that Claim 37 remains patentable over the prior art of record.

Claim 38 has been amended to conform with Claim 37 so as to ensure proper antecedent basis for all elements of the claim.

It is further noted with appreciation that Claims 2-4 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 2 and 3, both directly dependent upon Claim 1, have been rewritten in independent form, and therefore should now be allowable. Claim 2 has also been amended to correct a spelling error.

### CONCLUSION

This, it is respectfully submitted that all of the Examiner's rejections have been addressed and it is further respectfully submitted that all of the pending claims, Claims 1-5, 16-26, and 37-41 are allowable over the prior art and allowance is respectfully requested.

If, however, any issues remain, the Examiner is cordially invited to contact the undersigned so that any such issues may be promptly resolved.

Although fees are dealt with in an accompanying sheet, if there are any additional charges with respect to this Amendment and Response, please charge them to Deposit Account No. 06-1130 maintained by Applicants' Attorneys.

Respectfully submitted,

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